

REMARKS

Claims 1-25 are pending in this application.

The Applicant respectfully requests the admittance of this amendment, to place the claims in a better condition for allowance or appeal. The Applicant respectfully suggests that this amendment adds no new matter, and does not require an additional search. Claims 1 and 2 are amended to clearly identify the selected piece of clothing is for use by the user, and claims 14, 15, and 20 are amended to remove adjectives objected to by the Examiner.

In the subject Office action, the Examiner states that "The claims and only the claims form the metes and bounds of the invention." The Applicant concurs with this statement, but notes the following: "Although it is improper to read a limitation from the specification into the claims, *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998), **"[c]laims must be read in view of the specification, of which they are a part,"** *Markman*, 52 F.3d at 979; see also *United States v. Adams*, 383 U.S. 39, 49 (1966) (**"[C]laims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention."**); *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987) (**"Claims are not interpreted in a vacuum, but are part of and are read in light of the specification."**)" (*Microsoft Corp. v. Multi-Tech Systems, Inc.*, Slip Op. 03-1138, Fed. Cir., 3 February 2004, emphasis added).

The specification, and the claims, specifically recite a system and a method that provides recommendations **to a user** regarding the selection of a piece of clothing for the user. The cited prior art teaches a system and method for providing a recommendation **to a salesperson** regarding which piece of clothing to recommend to a user. Each of the Applicant's independent claims clearly distinguish the claimed user-system from the prior-art sales-system, as detailed below.

The Office action rejects claims 14, 15, and 20 under 35 U.S.C. 112, first paragraph, as failing to comply with the enabling requirement. Specifically, the Office action objects to the terms "compatibility distances", "preference weights", and "beyond the inventory". The Applicant respectfully traverses this rejection, because each of the terms are discernible from the specification. There is no requirement in patent law that all terms used in the claims must be literally found in the specification. However, in the interest of advancing prosecution in this case, the claims have been amended to replace "compatibility distances", "preference weights", and "beyond the inventory" with "distance", "weights", and "is not in the inventory", respectively. Each of the words "distance", "weight", and "inventory" appear in the Applicant's specification.

CLAIMS 1-7

The Office action specifically rejects claims 1-10 under 35 U.S.C. 102(e) over Suzuki (USP 6,313,745) at page 6, but also provides basis for rejecting each of claims 11-25. The following remarks address claims 1-25 and Suzuki. The Applicant respectfully traverses these rejections based on the Applicant's prior response, and the following remarks.

Each of independent claims 1 and 2, upon which claims 3-7 depend, specifically recite a system and method, respectively, that provides recommendations **to a user** for the selection of pieces of clothing that match a clothing profile of the user.

The Office action cites Suzuki's column 2, lines 10-23 for teaching providing recommendations to a user. The Applicant respectfully traverses this characterization of Suzuki. The text at Suzuki's column 2, lines 10-23, describes a user entering a fitting room of a store with merchandize items that contain tracking tags. Suzuki specifically teaches that the system "should display the fitting room number being utilized by a particular customer on an

in-store display terminal **accessible to a store clerk**. The system should further display information on the items being tried on... [and] should process the style, brand, color, and price data of the items... and provide recommendations of other items... consistent with the customer's profile information." Suzuki's system is specifically structured as a sales-aid, for use by the **store clerk**; it does not provide recommendations **to the user**, as specifically claimed in each of claims 1 and 2.

MPEP 2131 clearly states that, to support a rejection under 35 U.S.C. 102, "The **identical invention** must be shown in as **complete detail** as is contained in the ... **claim**." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As detailed above, Suzuki's invention is not identical to the Applicant's invention, and lacks at least one clearly distinguishing feature/detail of the Applicant's claimed invention. The Applicant specifically claims a system that provides a recommendation for the selection of a piece of clothing for use by the user, with the specific limitation that the recommendation is provided **to the user**. This specific element of the Applicant's claimed invention is not taught by Suzuki, and thus the Applicant respectfully maintains that claims 1 and 2, and thus claims 1-7, are patentable under 35 U.S.C. 102(a) over Suzuki.

The following remarks are further provided with regard to the dependent claims of claim 2.

In claim 3, the Applicant claims forming a collection of subsets of combined pieces, and selecting one of the subsets for recommendation to the user.

Suzuki is silent regarding forming subsets from which one subset is recommended. The Office action cites Suzuki, column 7, lines 4-9, for teaching the creation of a list of available pieces of clothing, and column 7, lines 4-7 for forming the collection of subsets and recommending at least one subset from the collection of

subsets. Suzuki column 7, lines 4-9 states: "information related to a brand being tried-on. The recommended items are bundled into a recommendation record 54 and transmitted to the in-store terminals 28-32 as part of the fitting room record. Based on the recommendation information, store clerks can render advice [to] customers in a more effective and efficient manner". As is clearly evident, Suzuki's column 7, lines 4-9 do not teach forming a collection of subsets of combined pieces, and does not teach selecting one of the subsets from the collection.

In claim 4, which is dependent upon claim 3, the Applicant claims the elimination of a subset from the collection of subsets when the subset is determined to be unsuitable for a present situation.

Suzuki is silent with regard to situation-dependent recommendations or eliminations. The Office action cites Suzuki, column 6, lines 60-67, for teaching the elimination of a subset from the collection of subsets, but the text at column 6, lines 60-67 does not refer to eliminations, or collections, or subsets.

In claim 6, the Applicant claims input means for inputting a purpose for which the piece of clothing has been selected, and providing the recommendation based on the purpose.

Suzuki is silent with regard to inputting a purpose for which the piece of clothing has been selected, and silent with regard to basing the recommendation on the purpose. The Office action cites Suzuki, column 2, lines 25-39 for this teaching. At the referenced text, Suzuki teaches that the input to the system is product identifiers, obtained from the tags that are attached to each item brought into the fitting room. "A processor... uses the product identifier to retrieve product profile information about the item, and recommends other items based on this [product profile] information" (Suzuki, column 2, lines 36-39).

In claim 7, which is dependent upon claim 6, the purpose for which the piece of clothing has been selected is based on an appointment in an electronic calendar.

Suzuki is silent with regard to inputting a purpose for the selection of clothing, and silent with regard to basing any decisions on a scheduled appointment. The Office action cites Suzuki, column 8, lines 43-57 for this teaching. At the referenced text, Suzuki describes the layout of the data in a customer's purchase and trial history data. The described data does not include a purpose, and does not include an appointment.

Based on the remarks above, the Applicant respectfully requests the Examiner's reconsideration of the rejections of claims 1-7 under 35 U.S.C. 102 over Suzuki, particularly in view of MPEP 2131.

CLAIMS 8-10

Independent claim 8, upon which claims 9-10 depend, claims a method of providing a targeted clothing advertisement **to a user**, comprising matching a clothing product to a clothing profile, and sending an identifier of the clothing product **to the user**.

As noted above, Suzuki specifically teaches a sales-aid wherein product information is sent **to a store clerk** to facilitate sales to a user. Suzuki is silent with regard to sending advertisements to a user. The Office action cites Suzuki, column 6, line 60 through column 7, line 9 for this teaching. At the referenced text, Suzuki specifically teaches sending any and all recommendations to the store clerk.

In claim 9, the Applicant claims rendering a representation of the advertised item to the user.

Suzuki does not teach the rendering of representations of an advertised item, nor does Suzuki teach providing a rendering of anything to the user. The Office action cites Suzuki, column 6, line 60 through column 7, line 9 for this teaching. At the

referenced text, Suzuki specifically teaches that "The recommended items are bundled into a recommendation record 54 and transmitted to the in-store terminals 28-32 as part of the fitting room record" (Suzuki, column 7, lines 4-7). These records are not said to contain renderings of representations of the recommended items.

Based on the remarks above, the Applicant respectfully requests the Examiner's reconsideration of the rejections of claims 8-10 under 35 U.S.C. 102 over Suzuki, particularly in view of MPEP 2131.

CLAIMS 11-15 and 16-25

Independent claim 11, upon which claims 12-15 depend, and claim 16, upon which claims 17-25 depend, specifically recite providing a recommendation for an ensemble to a user, based on an inventory of the user's apparel.

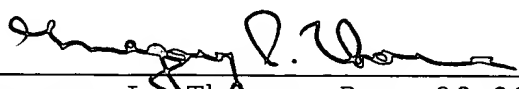
Suzuki is silent with regard providing recommendations **to a user**, silent with regard to recommending **an ensemble**, and silent with regard to basing the recommendation for the ensemble on the **user's inventory** of apparel. The Office action cites column 8, lines 43-67 for these teachings. At the cited text, Suzuki teaches maintaining a record of the user's prior purchases and trial history "to better determine the customer's tastes... [and] uses a customer's purchase and trial history to eliminate items from the recommendation record if they have already been purchased or tried-on by the customer. However, if a product that the customer has tried-on in the past but has not purchased is on sale, the brand analysis module 46 retrieves the product for recommendation to the customer." (Suzuki, column 8, lines 59-67.) Nowhere in this text does Suzuki mention forming an ensemble from items in the user's inventory; and, such a formation would be contrary to the expressed purpose of Suzuki's invention: facilitating the sale of items to a user. If an ensemble is formed from the user's inventory, the user has no need to purchase additional items.

The Office action also asserts that Suzuki's records of prior sales to the user constitute the Applicant's claimed inventory of apparel possessed by the user. The applicants respectfully traverse this assertion. Although there may be some items of apparel common to both the records of prior sales and the inventory of apparel possessed by the user, the record of prior sales may include items that are no longer possessed by the user, and inventory will include items possessed by the user that are not included in the records of prior sales, such as gifts, and items purchased elsewhere. The Examiner's attention is again requested to MPEP 2131: "The **identical invention** must be shown in as **complete detail** as is contained in the ... **claim**."

Based on the remarks above, the Applicant respectfully requests the Examiner's reconsideration of the rejections of claims 11-15 under 35 U.S.C. 102 over Suzuki, particularly in view of MPEP 2131.

In view of the foregoing, the Applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the present application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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